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08/987,995	12/10/97	SEYMOUR	J 200-007711-U
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EXAMINER

MEHREZOUR, N

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 08/987995
Filing Date: 12/10/97
Appellant(s): James Nicholas Seymour

For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 9/22/00.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained

in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 12-19 stand or fall together with respect to the patentability of Claim 12 and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,479,486	Saji	12-1995
5,760,690	French	6-1998

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims 12-19:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 12-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saji (US Patent Number 5,479,486) in view of French (US Patent Number 5,760,690).

Regarding **Claims 12, 19**, Saji teaches a radio telephone 1 including a rechargeable power supply and having coupling (b1, b2, a1, a2, 10), means for connecting to a charger unit 6 for charging the power supply, the radio telephone comprising (See figure 1):

the charging apparatus is provided with setting means for detecting whether the telephone apparatus is set in the predetermined portion of the charging apparatus or not, connection condition detecting means for detecting whether the contact of the telephone apparatus are electrically connected or not (Column 3 lines 10-14).

Saji fails to teach means responsive to the sensor sensing the absence of the charging unit for automatically inhibiting operation of the radio telephone. However, French teaches a portable apparatus providing alarm system, which includes various sensors for monitoring whether the system is being moved from a stationary position (Column 2 lines 62-67). Therefore unauthorized movement of the system as a whole is prevented (Column 3 lines 9-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the above teaching of French to Saji, in order to provide security for the cellular users.

Regarding **Claim 13**, Saji fails to teach a radio telephone wherein the sensor and locking means are operative for a power on mode of the portable electronic apparatus. However French teaches a portable apparatus wherein more sophisticated integration may also be accomplished by coupling disable circuit 28 to the computer's system to provide the ability to send commands and data to the CPU in order to place the CPU in a locked (inoperable) mode (Column 5 lines 37-43). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the above teaching of French to Saji, in order to provide security for the cellular users.

Regarding **Claim 14**, Saji fails to teach a radio telephone wherein the inhibiting means is adapted to inhibit access to information stored in the portable electronic apparatus. However French teaches a portable apparatus which is useless to a would be-thief and less likely to be stolen. With such a system the data and information stored on a computer system employing such an alarm is protected from unauthorized access by a thief (Column 2 lines 17-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the above teaching of French to Saji, in order to provide security for the cellular users.

Regarding **Claims 15-16**, Saji as modified by French discloses the inhibiting means. Therefore ~~the user cannot make an outgoing call, and~~ inhibits access to subscriber identity information stored in the memory.

Regarding **Claim 17**, Saji teaches a radio telephone wherein the sensor is adapted to sense charging voltage for charging the rechargeable power supply (See figure 1 numeral 32).

Regarding **Claim 18**, Saji fails to teach a system wherein operation of the radio telephone is restorable responsive to a security code input to the portable electronic apparatus. However

French teaches a portable system which includes a disabling circuit. Upon unauthorized tampering, the system is disabled functionally until the proper keycode is entered via a keypad interface (Column 2 lines 10-14, Column 5 lines 15-18). Therefore, it would have been obvious to ordinary skill in the art at the time the invention is made to provide the above teaching of French to Saji, in order to provide security for the cellular users.

(11) Response to Argument

Appellant's argues:

Regarding **Claims 12, 19**, French disclose a portable computer (not a radio telephone) with an integrated alarm which can disable the computer upon its unauthorized movement from a stationary position, there is no teaching or suggestion that such unauthorized movement has anything whatsoever to do with its access to a charging unit.

Examiner response:

It is true that French disclose a portable computer not a radio telephone. However if the portable electronic device (computer) is removed from the stationary position, operation of the portable unit is inhibited. Therefore the concept can apply to the radio telephone.

Further in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant's argues:

Regarding **Claims 13-14**, French cannot support Saji in a proper rejection of a claimed construction combining a charging unit and an inhibiting means.

Examiner response:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the security features that are used in the electronic devices of French can be used in the radio telephone of Saji.

Appellant's argues:

Regarding **Claims 15-16**, the sensing means sense absence of the charging unit and the inhibiting means is responsive to the sensing means to disable operation of the radio telephone. The French patent discloses no such capability and the Saji patent disclose no such capability, nor can their combination result in such a capability.

Examiner response:

In response to appellant's argument, regarding Claims 15-16, the Examiner, believes that the lap top computer and radio telephone are both electronic devices and used for communication. Therefore the security features that are used in the lap top of French can be used in the radio telephone of Saji. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Appellant's argues:

Regarding **Claim 17**, while this may be a true statement in and of itself, Saji simply does not disclose the claimed invention.

Examiner response:

In response to appellant's argument, regarding Claim 17, appellant's agrees that Saji shows the claim feature ^{but} ~~as to~~ not showing claim invention. Examiner has described in detail how the reference read on the disclose invention.

Appellant's argues:

Regarding **Claim 18**, French disclose a disabling circuit, that disabling circuit is not in any manner related to a charging unit.

Examiner response:

In response to appellant's argument, regarding Claim 18, the Examiner, believes that the lap top computer and radio telephone are both electronic devices and used for communication.

Therefore the security feature that are used in the lap top of French can be used in the radio telephone of Saji. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

NM

N.M.

December 4, 2000

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Conferences:

SPE Eisenzopf, Reinhard *RE*
PE Vo, Nguyen *nv*